

PATENT  
Agent's Docket  
No. 531-USA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the matter of:      SEGUIN et al.  
Serial No.:            10/635,637  
Filed:                  August 7, 2003  
For:                    OPTICAL COMPONENT PACKAGING DEVICE  
Examiner:              K. Cyrus Kianni  
Art Unit:               2883

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

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RESPONSE TO  
RESTRICTION REQUIREMENT

Sir:

This is in reply to the Office Action dated November 29, 2004, in which the Examiner has required restriction to one of the following groups of claims:

- I.      Claims 1-29; and
- II.     Claims 30-34.

Although both groups of claims are directed to an optical component packaging device, the Examiner stated that none of the claims are generic and for this reason requested restriction between the two groups.

Provisionally, the applicants elect Group I, namely claims 1-29 for further prosecution in this application and claims 30-34 are withdrawn, subject to applicants' right to re-file these claims in a divisional application.

No amendment of inventorship is required in the present provisional election.

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The applicants, however, traverse this Examiner's request for restriction for the following reasons:

First, 35 U.S.C. 121 to which the Examiner has referred does not at all require "to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable". Nowhere does 35 U.S.C. 121 refer to "generic claim" or the like, but rather it indicates that "If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." It is respectfully submitted that the Examiner has not demonstrated that in the present case, the two groups of claims relate to "two independent and distinct inventions" and therefore his requirement for restriction is not justified.

In fact MPEP § 808.02 states the following:

Where the related inventions as claimed are shown to be distinct under the criteria of MPEP § 806.05(c) - § 806.05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

(A) **Separate classification thereof:** This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) **A separate status in the art when they are classifiable together:** Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) **A different field of search:** Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

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It is submitted that in the present case the Examiner has not established any of the above conditions for restriction. As indicated in the last paragraph of the preceding page, in the present case the classification is the same and the field of search is the same for both groups of claims, and, therefore, no reasons exist for dividing among these two groups of claims.

The Examiner is, therefore, requested to withdraw the restriction requirement in this case, or explain how he has complied with the provisions of MPEP § 808.02.

Respectfully submitted,



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GJP/pp  
December 28, 2004